

REMARKS

In the office action under reply, the Examiner has rejected the claims as follows:

1. Under 35. U.S.C. §112, second paragraph, as indefinite (claims 28, 29, 32, 33, and 62); and
2. Under 35 U.S.C. §102(b) as anticipated by various references (claims 36 and 63).

Claims 1, 3-13, 30, 31, 34, and 35 were objected to for containing subject matter drawn to non-elected species, but were indicated as allowable if limited to the searched and examined subgenus, i.e., the subgenus wherein Z is sulfur.

The Examiner additionally indicated that claims 28, 29, 32, 33, and 62 would also be allowable if they were amended to overcome the rejections under 35. U.S.C. §112, second paragraph, and limited to the searched and examined subgenus.

In the present amendment, claim 62 has been canceled and claims 1, 3, 4, 28, 30, 32, 34, 36, 38, and 39 have been amended. Thus, claims 1, 3-13, 28-36, 38-47, and 63 are now pending. The Examiner's rejections and objections are addressed in full by the above amendments.

The Amendments to the Claims:

Independent claims 1, 28, 30, 32, 34, and 36 have been amended to specify that the Z substituent is sulfur. Dependent claims 3 and 38 have been accordingly amended to remove redundant Z definitions.

It is to be noted that Applicants have made these amendments only in the interest of expediting prosecution and expressly reserve the right to pursue claims to any excluded subject matter in later continuing and/or divisional applications.

Claims 28 and 32 have also been amended to address the Examiners comments regarding the term "usefully" and claim 39 has been amended to correct a typographical error.

Claim 62 has been canceled. Cancellation of this claim is without prejudice, without intent to acquiesce in any rejection of record, and without intent to abandon any previously claimed subject matter.

Accordingly, no new matter has been added and entry of the new claims is in order.

The Rejections Under 35. U.S.C. §112, Second Paragraph:

The Examiner has rejected claims 28, 29, 32, 33, and 62 as indefinite for failing to particularly point out and distinctly claim the subject matter that the applicants regard as their invention.

Claims 28 and 32 were specifically rejected for their inclusion of the term "usefully." In response, Applicants have amended claims 28 and 32 to remove the objected to language.

Claim 62 was rejected as the Examiner views the limitation regarding the "therapeutically effective dose including at least one pharmaceutically acceptable excipient" as unclear.

As claim 62 has been canceled, the rejection as it pertains to this claim is now moot.

As the Examiner's specific rejections have all been addressed or rendered moot, Applicants request reconsideration and withdrawal of the rejection under 35. U.S.C. §112, second paragraph.

The Rejections Under 35 U.S.C. §102(b):

Claims 36 and 63 have been rejected over the following references:

1. Pomarnaka et al.
2. Dollinger et al.;
3. Overberger et al.;
4. U.S. Patent No. 2,937,172 to Shapiro et al.;
5. Abou-Ouf et al.;
6. Takematsu et al.;
7. Lorenz et al.;
8. Riebel et al.; and
9. Watanabe et al.

In each of the above references, the compounds disclosed therein contain a nitrogen atom in the Z position. As claims 36 and 63 have been amended to require that the Z position contain a sulfur atom, Applicants submit that the cited references fail to disclose each and every element of the pending claims as required by 35 U.S.C. §102. Reconsideration and withdrawal of the rejection in view of the attached amendments is respectfully requested.

Once again, it is to be noted that Applicants have limited claims 36 and 63 to sulfur compounds only in the interest of expediting prosecution of the present application. It is Applicants full intention to pursue claims to any excluded subject matter, i.e., compounds wherein Z is O or NR⁵, in later continuing and/or divisional applications.

The Examiner's Comments Regarding the Allowability of Claims 1, 3-13, 28-35, and 62:

As stated above, the Examiner has indicated that claims 1, 3-13, 28-35, and 62 would be allowable if limited to the searched and examined subgenus and amended to address the rejections brought under 35 U.S.C. §112, second paragraph. While claims 38-47 were not specifically referenced in the Examiner's statements, Applicants assume that they are also allowable save for their dependence upon a rejected base claim.

Given that the independent claims have been amended to restrict the claims to the searched and examined subgenus wherein Z is sulfur, Applicants submit that the pending claims are in condition for allowance.

CONCLUSION

For the foregoing reasons, applicant submits that the claims comply with the requirements of 35 U.S.C. §112 and 35 U.S.C. §102(b) are in condition for allowance. A Notice of Allowance is requested, and a prompt mailing thereof would be much appreciated.

Should the Examiner have any questions regarding this amendment, he or she is welcomed to contact the undersigned attorney at (312) 913-2123.

Respectfully submitted,
MCDONNELL BOEHNEN
HULBERT & BERGHOFF

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By: 

A. BLAIR HUGHES
Reg. No. 32,901